REMARKS

Claims 1-25 are in this application.

Initially, the Examiner objected to the Terminal Disclaimer previously filed in this matter and again rejected the claims under the judicially created doctrine of nonstatutory double patenting. Submitted with this response is another executed terminal disclaimer effectively disclaiming any portion of the instant patent application which would extend beyond the life of any patent which may issue from U.S. Patent Application Serial No. 10/408,700. Accordingly, it is requested that the rejection be withdrawn.

In the office action of April 25, 2005, claims 16 and 25 are objected to for certain formalities. It is submitted that these formalities have been overcome by the instant claim amendments. Accordingly, it is requested that the objections to claims 16 and 25 be withdrawn.

Next the office action rejects claims 17-25 under 35 U.S.C. § 112, second paragraph. It is submitted that independent claim 17 has been herewith amended and overcome the Examiner's stated grounds for rejection. Accordingly, it is request that the rejection be withdrawn.

Finally, in the office action claims 1-25 are rejected under 35 U.S.C. § 103(a) as unpatentable over, U.S. Patent No. 5,474,235 to Cole et al in view of U.S. Patent No. 5,178,643 to Schimweg. The rejections are respectfully traversed for at least the following reasons.

It is well-settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, "obvious to try" is not the standard under 35 U.S.C. §103. *In re Fine,* 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780,

1783-1784 (Fed. Cir. 1992): "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification." Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Considering the law in light of the present facts, it is respectfully submitted that the Examiner has failed to provide any motivation to combine the teachings of Cole and Schwimweg. The two references are in very different classifications, which suggest that they concern matters which would not be readily looked to for combination. Further, it is respectfully submitted that one working with devices concerning spray nozzles such as that described by Cole, would be unlikely to look to art concerning honing tools and the application of abrasives as described by Schwimweg. Indeed, it is the elimination of abrasive effects that is the focus of the present invention.

Further, as pointed out by the Examiner the device described in Cole, already includes a lubricating coating of Teflon. Thus there is no suggestion in Cole that this coating is insufficient for its intended purpose or that there is any need to apply a Teflon impregnated metal coating. The only suggestion that the Teflon coating of Cole is ineffective and therefore requires a different plating comes from the instant application. As the examiner is aware the application itself cannot provide the suggestion to combine reference. Accordingly, because it is submitted that the Examiner has improperly combined references for which the only suggestion of combination comes from the instant application itself, it is requested that the rejection be withdrawn.

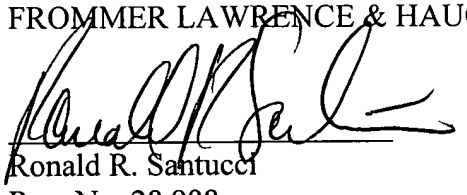
Conclusion

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited reference, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 
Ronald R. Santucci
Reg. No. 28,988
(212) 588-0800